



UNITED STATES DEPARTMENT OF COMMERCE
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Washington, D.C. 20231

DATE: July 10, 1991

TO: John F. Terapane, Jr.
Director, Group 120

FROM: Jeff Nase *JN*

SUBJECT: Outstanding Petitions Awaiting Decision for
Correction of Inventorship

Since you do not receive a copy of the PALM report which pertains to petitions to correct inventorship rendered by your Group, a copy thereof is attached hereto. It is noted that the PALM report discloses that there is an outstanding petition which has not been acted upon, or, if acted upon, has not been entered into PALM. This case should be obtained and appropriate action taken on the petition to correct inventorship. If the petition has already been acted upon, then the decision rendered and date mailed should be entered into PALM in order to clear this petition from the report.

Attachment: Copy of PALM Report relating to Petitions to Correct
Inventorship

PALM III

PETITIONS AWAITING DECISION REPORT

REPORT PERIOD: 06/01/91 THRU 06/30/91

FOR DECIDING OFFICIAL: DEPUTY A/C FOR PATENTS

SERIAL NUMBER	INT NUM	CHRG LOC	DATE IN LOCATION	STAT	STATUS DATE	EXAM NUM	EXAMINER NAME	TYPE	RSTD	TYPE DECD	FIL DATE	PETITION ENT DATE	PETITION PENDING	
													DEC	PEND
05662257	910	910	07/10/90	151	11/08/85	333 69715	SMITH, JEFFREY	517	000	11/18/88	01/11/89	901	046	
06160795	910	910	03/01/90	100	04/16/81	121 61450	SCHWARTZ, RICHARD	517	000	05/03/89	05/12/89	780	789	
06652712	920	920	03/07/91	115	09/15/87	292 64129	NO NAME FOUND	517	000	01/17/89	04/19/89	803	895	
06693518	920	920	08/20/90	115	10/15/86	316 64229	NO NAME FOUND	517	000	05/24/89	05/31/89	761	768	
06779655	920	920	03/12/91	115	03/12/88	332 60345	ISABELLA, DAVID	517	000	12/23/88	03/14/89	839	081	
06891847	920	920	03/12/91	115	11/27/87	246 62108	YASICH, DANIEL	517	000	01/26/89	02/02/89	879	886	
06917190	920	920	03/12/91	115	09/30/87	211 59967	GELLNER, MICHAEL	517	000	02/28/89	05/16/89	776	853	
07000253	920	920	03/12/91	115	03/30/88	118 65850	JOHNSON, JERRY	517	000	03/06/89	03/20/89	833	847	
07043897	920	920	03/12/91	115	08/17/88	216 59021	ALBRITTON, CLARENCE	517	000	03/09/89	03/21/89	832	844	
07047809	920	920	03/12/91	115	08/23/88	111 61355	ROSENBERG, PETER	517	000	12/23/88	03/14/89	839	081	
07080674	920	920	05/03/90	161	06/05/89	245 61969	NO NAME FOUND	517	000	01/29/89	06/06/89	755	883	
07085341	920	920	11/27/90	115	01/04/89	216 61878	WALBERG, TERESA	517	000	05/19/89	05/31/89	761	773	
07117451	920	920	03/12/91	115	08/03/88	155 60676	LIPMAN, BERNARD	517	000	05/04/89	05/31/89	761	788	

CONFIDENTIAL DATA - PRIVACY ACT PROVISIONS APPLY

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REEXAMINATION

DECISION

A substantial new question of patentability affecting claims 1, 2, 4, 5, 7, 9, 12 and 13 of United States Patent Number 4,282,233 to Villani is raised by the request for reexamination.

The request indicates that requester considers the following claims to be unpatentable over the indicated prior art:

Claims 1, 2, 4, 9, 12 and 13 are considered to be invalid under 35 U.S.C. § 103 over Casy in view of Witiak and Kupchan;

Claims 5 and 7 are considered to be invalid under 35 U.S.C. § 103 over Villani (C5 1972) in view of Witiak and Kupchan;

Claims 1, 2, 4, 9, 12 and 13 are also *prima facie* invalid under 35 U.S.C. § 103 in view of Casy and Protiva;

Claims 5 and 7 are also *prima facie* invalid under 35 U.S.C. § 103 in view of Villani and Protiva.

It is agreed that the references of Casy, Villani (1972), Witiak, Kupchan and Protiva raise a substantial new question of patentability as presented supra. Casy

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and Villani (C5 1972) disclose methyl piperidylidene azadibenzo cycloheptene histamine antagonist compounds, which are structurally similar to the compounds of the patent ('233). Witiak discloses investigations of certain antihistamines adsorption, distribution and metabolic fate. Kupchan discloses the evaluation of certain derivatives of normeperidine as potential analgesics, including the N-methyl derivative and the N-ethoxycarbonyl derivative. Protiva discloses the chemistry of a number of tricyclic antihistamine compounds. The references relate to compounds that are structurally similar to the compounds of the instant claims (Casy and Villani) and to other compounds and considerations involving pharmaco-chemical aspects of antihistamines and as such raise a substantial new question of patentability for claims 1, 2, 4, 5, 7, 9, 12 and 13 of the Villani patent 4,282,233. Claims 3, 6, 8, 10 and 11 of Villani 4,282,233 will also be reexamined along with claims 1, 2, 4, 5, 7, 9, 12 and 13.

Extensions of time under 37 CFR 1.136(a) will not be permitted in these proceedings because the provisions of 37


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CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Accordingly, Office policy requires that reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.550(a)) and provides for extensions of time in reexamination proceedings as set forth in 37 CFR 1.550(c).

RAMSUER; aco

June 14, 1999

June 15, 1999


Robert W. Ramsuer
Art Unit 1613